

BORISLAV BOGDANOVIC ET AL.  
USSN 09/809,575

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

At the outset, Applicants acknowledge with appreciation the Examiner's indication that most of the previous rejections have been withdrawn.

Claims 1, 3-5, 8-9, 16 and 25 remain rejected under the judicially created doctrine of obviousness-type patenting as being unpatentable over claims 1-2 and 6 of U.S. Patent No. 6,117,372.

Claims 1-9, 15-21 and 25 were newly rejected under the judicially created doctrine of obviousness-type patenting as being unpatentable over claims 1-8 and 11-12 of U.S. Patent No. 6,221,285.

In response to *both* obviousness-type double patenting rejections, Applicants respectfully request that the Examiner reconsider and withdraw her position. A threshold issue for

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obviousness-type double patenting to lie is *obviousness*, and Applicants submit that obviousness is lacking here, so there can be no obviousness-type double patenting.

There is no doubt that the claims of the prior patents embrace the instant claims, in the way that a genus embraces a species. However, it is well-settled that a species can be nonobviousness even in view of a prior art genus embracing it if (1) the prior art lacks any teachings or suggestions for making the selections necessary to achieve the species or (2) the species is characterized by unexpected results relative to the genus.

Applicants submit that both (1) and (2) apply here. Accordingly, there is no obviousness-type double patenting.

In this regard, Applicants point out that the claims of the prior patents lack any teaching or suggestion of the second metal-containing compound, or of the second metal-containing compound "increasing the activity of [the] transition metal catalyst," as required by the instant claims. Accordingly, not only do the prior patents fail to teach or suggest the selections that would be necessary to achieve the instant claims, and, therefore, to make out a *prima facie* case of obviousness, but, as explained in the last paragraph on page 3 of the specification and continuing over to the top of page 8, the introduction of the second metal-containing compound is demonstrated in the examples in the specification to result in an unexpected, yet unmistakable, enhancement of the activity of the transition metal catalyst, which is proof of an unexpected

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result. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995). Further, the data in the instant specification are, in fact, commensurate in scope with the claims, as the claims require that the second metal-containing compound “[increase] the activity of [the] transition metal catalyst,” and, therefore, the claims cover only embodiments where the unexpected improvement demonstrated is realized.

There is nothing in the claims of the cited patent that teaches or suggests the second metal-containing compound, or the unexpected improvement demonstrated on the present record attendant to its use. Accordingly, the present claims are *not* obvious over the claims of Applicants’ prior patents. In the absence of obviousness, there cannot be obviousness-type double patenting—even if Applicants’ prior patents might technically be generic to the instant claims.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw these obviousness-type double patenting rejections. An early notice that these rejections have been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding

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objections and rejections.

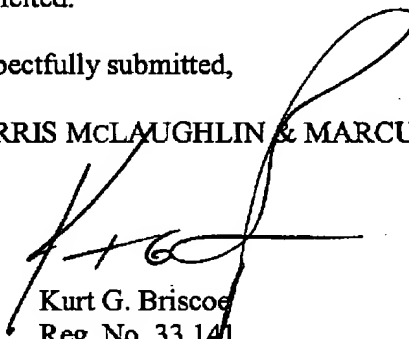
Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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By

  
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Request for Reconsideration under 37 CFR § 1.111 (5 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: June 30, 2003

By:

  
Kurt G. Briscoe